22-36, 38, 39, 40, and 42-44 withdrawn from consideration as being directed to non-elected subject matter. The above rejections and objection are addressed in part by the present amendments and are otherwise traversed by the arguments that follow.

THE AMENDMENTS

Claims 14 and 15 have been amended to specify that R^3 is a nonhydrogen substituent, i.e., a hydrocarbyl moiety in claim 14 and a lower alkyl moiety in claim 15. Support for these amendments is found throughout the specification and in the claims as originally filed.

Claims 14 and 21 have also been amended to correct various typographical and grammatical errors.

Claim 16 has been amended to be in accord with amended claims 14 and 15.

Claim 17 has been canceled as being redundant and the dependency of claim 18 has been corrected.

Accordingly, no new matter has been added and entry of the above amendments is proper.

THE REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 14-18, 21, 37, and 41 have been rejected under 35 U.S.C. §112, second paragraph, with the Examiner specifically referencing the presence of "R^{8a}" in claim 21 and the use of "inclusive" in the definition of "p" in claims 14 and 21.

In response to the rejections, applicants have amended claim 21 to properly recite "R^{8b}" and have removed the term "inclusive" from claims 14 and 21. Applicants wish to point out that the removal of the term "inclusive" is in no way intended to limit the scope of the claims or to abandon any previously claimed subject matter.

As all of the Examiner's specific 35 U.S.C. §112, second paragraph, rejections have been addressed, applicants respectfully request reconsideration and withdrawal of the rejection.

THE DOUBLE PATENTING REJECTION:

The Examiner has rejected claims 14-18, 21, 37, and 41 for obviousness-type double patenting over claims 1-16 of U.S. Patent No. 6,281,205 and claims 7-25 of U.S. Patent No. 6,054,446 under the judicially created doctrine of obviousness-type double patenting.

In response, applicants are submitting a Terminal Disclaimer with the present amendment, disclaiming the terminal portion of any patent issuing on the present application that would extend beyond the terms of U.S. Patent No. 6,281,205 and U.S. Patent No. 6,054,446. Submission of this Terminal Disclaimer is not intended as acquiescence in the double patenting rejection, but is solely for the purpose of expediting prosecution.

Reconsideration and withdrawal of the obviousness-type double patenting rejection over claims 1-16 of U.S. Patent No. 6,281,205 and claims 7-25 of U.S. Patent No. 6,054,446 are in order and are, accordingly, requested.

THE REJECTION UNDER 35 U.S.C. §102(B) AS ANTICIPATED BY PETERS ET AL.:

The Examiner has rejected claims 14 and 15 over Peters et al. (hereinafter "Peters"). The Examiner has specifically cited compound 8e in Peters and states that the compounds of claims 14 and 15 are anticipated when R^{10} is CH_3, R^{20} is OH, and R^1 to R^9 and R^{mod} are H.

The present invention is drawn to compounds having the structural formulas (V), (VI), and (VII) as depicted and defined in the pending claims, as well as pharmaceutical compositions comprised of compounds having the structure of formula (VII) and methods of treatment using these pharmaceutical compositions. Rejected independent claims 14 and 15 are specifically drawn to the compounds having structural formulas (V) and (VII), respectively.

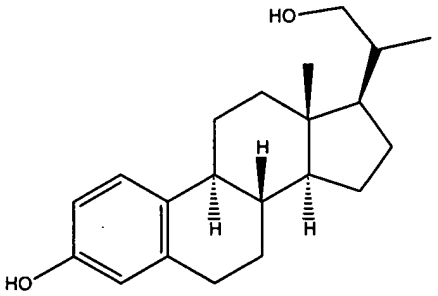
As amended, claims 14 and 15 now specify that, **within structural formula (V), R^3 must be a hydrocarbyl moiety and, within structural formula (VII), R^3 must be a lower alkyl moiety**. As the Examiner knows, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "Rejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art...." *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Air Products and Chemicals, Inc. v. Chas. Tanner Co.*, 219 USPQ 223, 231 (D.S.C.

1983); *Imperial Chemical Industries v. Henkel Corp.*, 215 USPQ 314, 323 (D. Del. 1982); *In re Samour*, 197 USPQ 1 (CCPA 1978).

In contrast to the presently claimed compounds, **Peters discloses only hydrogen atoms at the R^3 position within compound 8e** and fails to disclose any other compound that encompasses each and every element of the presently pending claims. Since Peters does not identically disclose every element of the claimed invention, the reference cannot anticipate independent claims 14 and 15 or any claims dependent therefrom. In addition, there is nothing in Peters to suggest placement of a hydrocarbyl moiety at the R^3 position. Reconsideration and withdrawal of the rejection are in order and are respectfully requested.

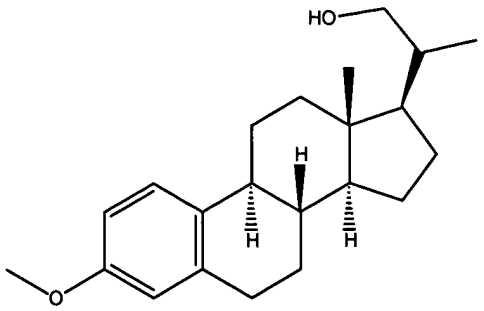
THE REJECTION UNDER 35 U.S.C. §102(B) AS ANTICIPATED BY MORITA ET AL.:

The Examiner has also rejected claims 14 and 15 over Morita et al. (hereinafter "Morita"). The Examiner has specifically cited compounds RN 73271-88-2 and 73436-61-0, which are viewed by the Examiner as anticipating the subject matter of claims 14 and 15 when R^{20} is a hydroxyl moiety and all other substituents are hydrogen. The structures of the specifically cited Morita compounds are as follows:



20-methyl-19-norpregna-1,3,5(10)-trien-3,21-diol

RN 73271-88-2



3-methoxy-19-norpregna-1,3,5(10)-trien-20-methanol

RN 73436-61-0

As discussed above, independent claims 14 and 15 have been amended to specify that, within structural formula (V), R^3 must be a hydrocarbyl moiety and, within structural formula (VII), R^3 must be a lower alkyl moiety. As was the case with the Peters reference, the compounds disclosed by Morita and cited by the Examiner contain a hydrogen atom at the R^3 position.

Since Morita does not identically disclose every element of the claimed invention, it, like Peters, cannot anticipate independent claims 14 and 15 or any claims dependent therefrom. In addition, there is nothing in Morita to suggest placement of a hydrocarbyl moiety at the R^3 position. Reconsideration and withdrawal of the rejection are in order and are respectfully requested.

CONCLUSION

For the above reasons, it is submitted that the application comports with all requirements of 35 U.S.C. §112, and that the pending claims define an invention that is patentable over the art. As the application should now be in condition for allowance, a prompt indication to that effect would be appreciated.

If the Examiner has any questions concerning this communication, or would like to discuss the application, the art, or other pertinent matters, she is welcome to contact the undersigned attorney at 650-330-0900.

Respectfully submitted,

By: _____

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